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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,072	08/29/2002	Daniel Larsson	1774/OK314	7234

7590 05/06/2004
John C Todaro
Darby & Darby
805 Third Avenue
New York, NY 10022-7513

EXAMINER

WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,072

Applicant(s)

LARSSON ET AL.

Examiner

Eric F Winakur

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 and 27-50 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19, 22, 23, 27-42, 45, 46 and 48 is/are rejected.
- 7) ☒ Claim(s) 15, 18, 20, 21, 43, 44, 47, 49 and 50 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08292002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 4, 13, 20, and 39 are objected to because of the following informalities: In claim 4, line 1, the term "is" should be inserted before "devised". In claims 13 and 39 it is noted that the European style of writing decimal numbers has been used. It appears that claim 20 should depend from claim 19 to provide proper antecedent basis for the claim terms. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 19, 22, 23, 36, 46, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 17, 19, 22, 36, 46, and 48, are indefinite, as they recite a broad limitation, the phrase "preferably" or "such as", and a narrow limitation. As such, it is unclear whether the claims are meant to be bounded by the broad or narrow recitation. With regard to claim 23, the claim elements appear to correspond with and essentially repeat the definitions of the elements found in the base claim; that is, it is unclear what further limitations are provided by claim 23.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 - 14, 16, 17, 22, 23, 27 - 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger in view of Katims (WO 97/06730 - cited by Applicant). Burger teaches a stimulator (Fig. 1, 6, 7 - 9; column 6, line 28 - column 7, line 31) for applying laser (Figs. 7 - 9) or electrical pulses (Fig. 6) to a subject for evoked response stimulation. The pulse generator includes a pulse width modulating means 27. Burger discusses "Selection of Operating Parameters" beginning in column 8. However, Burger does not teach an indication mechanism or registration mechanism for recording the subject's response. Katims teaches a measurement device for applying electrical stimulation to a subject and a subject activated device 101 for indicating when the subject senses certain events. Further, the device of Katims coordinates the stimulation and indications for evaluating the test subject's condition. Katims discusses control of frequency and intensity (amplitude) during stimulation procedures. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Burger to include indication and registration means, as taught by Katims, to allow automated data collection and analysis. With regard to claims 9, and 34, it is noted that while Burger discloses a voltage controlled energy applicator, a current controlled applicator is merely an equivalent alternate expedient. As such, it would have been within the skill level of the art to modify the stimulator to use a current controlled energy applicator, since it has generally been held to be within the skill level of the art to substitute alternate equivalent expedients.

Allowable Subject Matter

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest a sensation measuring device or method that includes application of thermal energy between initial and predetermined maximum or minimum temperature points or using cooling as a stimulus.

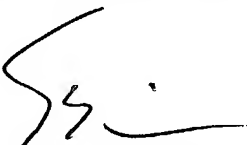
7. Claims 15, 18, 20, 21, 43, 44, 47, 49, and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The objection to claim 20 in paragraph 1 must also be addressed.

8. Claims 19, 46, and 48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703/308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur
Primary Examiner
Art Unit 3736

3 May 2004